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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,195	10/20/2003	Triveni P. Shukla	00030-001	4432

7590 04/06/2005

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EXAMINER
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DONOVAN, MAUREEN C

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,195

Applicant(s)

SHUKLA ET AL.

Examiner

Maureen C Donovan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/28/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to communications: Amendment A, filed 28 January 2005.
2. Claims 1,2,6,7,8 and 10-12 are pending.
3. Claims 3-5 and 9 have been cancelled.
4. The rejections made to claims 3-5 under U.S.C. 112, second paragraph, in the previous Office action mailed 29 October 2004 are withdrawn in light of the claim amendments.

### ***Specification***

1. Applicant indicates in the arguments filed 28 January 2005 that US patent number 5,766,622 was incorporated by reference in the original as-filed application. The attempt to incorporate subject matter into this application by reference to US patent number 5,766,622 is however improper because mere reference to another application, patent or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973).

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,2,6,7,8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by McGinley, US patent number 5,192,569.

McGinley discloses food products containing an aqueous dispersion comprised of a dietary fiber gel, water and lipid. McGinley discloses the use of microcrystalline cellulose (see Column 4, lines 15-16), which is a source of dietary fiber and is a gel in water (see Column 3, lines 39-50), therefore is a dietary fiber gel. McGinley discloses the use of a lipid with the dietary fiber gel (see Column 6, lines 45-68). McGinley discloses adding the dietary fiber and lipid to water to form an aqueous dispersion (see Column 7, lines 59-63) and then adding that

aqueous dispersion to a food product as a fat replacement (see Column 1, lines 25-30 and 36-37). The aqueous dispersion as disclosed by McGinley comprises a dietary fiber gel, water and lipid; thus, it is the same as the emulsified liquid shortening composition, even though such term is not used in the reference. McGinley discloses that the solids contained within the dietary fiber gel represent 1-50% by weight of the overall food formulation (see Column 8, lines 5-20), which encompasses weight percents in the range as instantly claimed. McGinley teaches the use of the mixture of dietary fiber gel, water and lipid in dry or dispersed form in various foodstuffs including sauces and other water based foods (see Column 7, lines 1-2 and lines 57-68 and see Column 8, lines 21-25). The Office interprets the reference to inherently disclose sauces with the different flavors as claimed (cheese), to inherently disclose creamy sauces, gravies as well as disclose sauce mixes; since cheese, gravy and creamy are all types of sauces and are all water based foods, and since the reference discloses the use of the mixture in dry or dispersed form which encompasses a sauce mix and a reconstituted sauce.

### ***Response to Arguments***

Applicant's arguments filed 28 January 2005 have been fully considered but they are not persuasive. At page 8 of the response, applicant states that the dietary fiber of McGinley does not meet the limitations of the instant invention by not being amorphous, non-coated or insoluble and that McGinley is not directed towards using this fat substitute in sauces. Applicant also states on page 6 of the response that the lipid of McGinley is not the same as the lipid as instantly claimed which is a fat and oil component. This is not deemed persuasive.

In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the dietary fiber be non-coated, amorphous and insoluble and that the lipid be a fat and oil component) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, the lipid of McGinley is interpreted to be a fat and oil component (see McGinley, Column 4, lines 45-54), as the difference is not apparent between a lipid used to impart flavor and one that is a component,

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since a lipid used as a component only requires the presence of the lipid, which a lipid used as a flavorant would satisfy.

Applicant has stated that the McGinley reference does not teach sauces, however attention is directed to Column 8, line 24, wherein McGinley explicitly discloses using the referenced invention in sauces.

### *Response to Amendment*

3. The amendment filed 28 January 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The sentences, which were added to the disclosure in the response filed 22 December 2004, that begin with:

“The dietary fiber gels are produced” , “Dietary fiber gels in a hydrated form”  
and

“A physically smooth morphology”

These sentences introduce new matter regarding the production of the dietary fiber, its morphology and its physical state. Although applicant states that this matter can be added from US patent number 5,766,662; as noted above, US patent number 5,766,622 is not viewed to be incorporated by reference and therefore these amendments do introduce new matter.

Additionally, the sentence beginning “Without being bound...” that was added to the disclosure in the response filed <sup>28 January 2005 (MCA)</sup> ~~22 December 2004~~ is also new matter. This sentence introduces theories based on the information presented in US patent number 5,766,662. Since this sentence introduces information that is not present in US patent number 5,766,662, even if this patent is properly incorporated, this sentence would still be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,2,6,7,8 and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/689274. The reference and rejection are incorporated as cited against claims 1-10 in the previous Office action mailed 29 October 2004. This is a provisional obviousness-type double patenting rejection.

Applicant's arguments filed 28 January 2005 have been fully considered but they are not persuasive. At page 10 of the response, applicant states that Application No. 10/689274 claims soups, which are patentably distinct from sauces as instantly claimed. This is not deemed persuasive. The applicant argues that in order for sauce to add extra flavor to food it has to be able to adhere or cling to food, this is not found in any dictionary definition of sauce or in either application's disclosure or claims. Further, the applicant does not explain what gives the sauce the ability to cling or adhere and therefore the compositional difference between a sauce and a soup has not been shown. It is submitted that both sauces and soups can have varying degrees of thickness, the thickness not lending any patentable distinction between the two foods. The use of a sauce as a flavoring also does not distinguish it as compositionally different from a sauce. A soup composition that was used on a food product would thereby be defined as a sauce, but the same composition could be eaten alone and thereby be defined as a soup, the composition remaining the same. Therefore the patentable distinctness between soups and sauces has not

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been shown. Additionally, although the applications have claimed different ranges of emulsified liquid shortening, the ranges do overlap. Finally, it is submitted that the Office action mailed 29 October 2004 did address why the two applications were not patentably distinct in saying on pages 4-5 that sauces and soups were both water based foods, that can have different flavors and be presented in reconstituted or dried format.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen C Donovan whose telephone number is (571) 272-2739. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCD

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**